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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/620,525	07/20/2000	Bruce E. Novich	1596C4	2888

7590 04/26/2004

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EXAMINER

GRAY, JILL M

ART UNIT PAPER NUMBER

1774

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/620,525

Applicant(s)

NOVICH ET AL.

Examiner

Jill M. Gray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-63 is/are pending in the application.
- 4a) Of the above claim(s) 9-12, 15-17 and 33-63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-8, 13-14, 18-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Upon further consideration, the rejection of claims 1, 4-8, and 18-30 under 35 U.S.C. 103(a) as being unpatentable over Sakaguchi et al, 4,006,272 in view of Raghupathi et al, 6,139,958 is withdrawn.

The rejection of claims 1, 4-8, 13-14, and 18-32 under 35 U.S.C. 112, first paragraph is withdrawn in view of applicants' arguments.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-8, 13-14, and 18-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kotera et al, 4,340,519 (Kotera) in view of Raghupathi et al, 6,139,958 (Raghupathi), for reasons of record.

### ***Response to Arguments***

Applicant's arguments filed January 27, 2004 have been fully considered but they are not persuasive.

Applicants argue that the examiner has not shown that Kotera expressly or inherently teaches "a plurality of discrete particles" as recited in claim 1 of the present invention and as explained by applicants and that Raghupathi can not cure this

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deficiency, further arguing that the examiner has not properly shown, nor do the references contain, the motivation to combine the two compositions.

In this concern, Kotera teaches the inclusion of the same type of inorganic particles that are disclosed by applicants as being suitable as "discrete particles" in the present invention, such as talc, clay, graphite, carbonate, or carbon black. See column 9, lines 61-66 and column 8, lines 30-56. Because the skilled artisan does not generally use a single particle of talc or a single graphite particle, one can reasonably presume that Kotera does in fact teach and suggest "a plurality of discrete particles", as required by present claim 1. As to the motivation to combine the two compositions, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Applicants argue that the examiner's only statement regarding motivation in the rejection pertains to the glass fibers of claims 6-8, wherein the use of general, non-specific and perfunctory statements cannot establish a prima facie case of obviousness. Applicants further argue that the examiner has proffered no evidence why one skilled in the art would choose the glass fibers of Raghupathi from the multitude of glass fibers available in the technology, thus, there is no motivation to combine the teachings of Kotera and Raghupathi as suggested by the examiner.

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In this concern, Raghupathi is relied upon for all that he would have reasonably imparted to one of ordinary skill in the art at the time the invention was made, namely, that the formation of glass fiber products such as panels using fiberizable glass materials of the type contemplated by applicants is well known in the art. Kotera teaches that his composition can be used to surface treat plastic and glass products, wherein said treated products show excellent transparency, drip-proof and durability and are suitable as materials for windows, lens or the like, (more specifically, panels). Raghupathi teaches that it is known in the art to form translucent and transparent panels from glass fibers (column 1, lines 19-34) and that glass fiberizable materials such as of E-glass, A-glass, C-glass and S-glass and derivatives thereof can be chemically treated with a polyester based treating composition, said treated fibers being used in the production of clear or translucent panels (column 8, line 14 through column 9, line 28). Though Kotera does not specifically teach glass fibers, and in particular E-glass fibers, it is the examiner's position that one of ordinary skill in the art concerned with the production of plastic and glass products having excellent transparency that could be used in the formation of windows, lens, and the like, at the time the invention was made, would have been reasonably motivated from the disclosure of Raghupathi to modify the teachings of Kotera by surface treating glass fiberizable material known to be suitable for the production of clear and/or translucent panels, said glass fiberizable material being of the type taught by Raghupathi and as contemplated by applicants in claims 6-8.

Therefore, the examiner's position remains that when considered as a whole, the combined teachings of Kotera and Raghupathi would have rendered obvious the invention as claimed in present claims 1, 4-8, 13-14, and 18-32.

No claims are allowed.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-F 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jill M. Gray  
Examiner  
Art Unit 1774

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SUPERVISORY PATENT EXAMINER  
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